

The opinion in support of the decision being entered today was not written  
for publication and is not binding precedent of the Board.

Paper No. 20

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte KEVIN R. BOYLE

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Appeal No. 2005-0498  
Application No. 09/616,635

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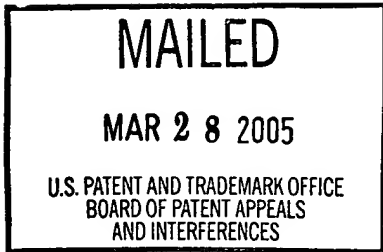
ON BRIEF

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Before JERRY SMITH, NASE and BAHR, Administrative Patent Judges.  
BAHR, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1-18,  
which are all of the claims pending in this application.



BACKGROUND

The appellant's invention relates to a body-worn communications apparatus. A copy of the claims under appeal is set forth in the appendix to the appellant's brief.

The examiner relied upon the following prior art references in rejecting the appealed claims:

Houlihan	5,467,324	Nov. 14, 1995
Shiraki	6,028,556	Feb. 22, 2000
Hirai et al. (Hirai)	6,429,829	Aug. 6, 2002
McLean	2,036,447	Jun. 25, 1980
(British patent application)		
Barnard	WO 00/13329	Mar. 9, 2000
(International patent application publication)		

The following rejections are before us for review.

Claims 1, 2, 5, 7, 9-11, 14, 17 and 18 stand rejected under 35 U.S.C. § 103 as being unpatentable over Houlihan in view of Shiraki.

Claims 3 and 12 stand rejected under 35 U.S.C. § 103 as being unpatentable over Houlihan in view of Shiraki and Hirai.

Claims 4 and 13 stand rejected under 35 U.S.C. § 103 as being unpatentable over Houlihan in view of Shiraki and Barnard.

Claims 6, 8, 15 and 16 stand rejected under 35 U.S.C. § 103 as being unpatentable over Houlihan in view of Shiraki and McLean.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejections, we make reference to the answer (Paper No. 16) for the examiner's complete reasoning in support of the rejections and to the brief and reply brief (Paper Nos. 15 and 17) for the appellant's arguments thereagainst.

### OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellant's specification and claims, to the applied references, and to the respective positions articulated by the appellant and the examiner. As a consequence of our review, we make the determinations which follow.

Houlihan discloses a wristwatch radiotelephone having a voice port 134 mounted on the end of a retractable and extendable tether member 136 which includes an antenna wire for the radiotelephone circuitry so that when voice port 134 is pulled out to deploy that port from the remainder of the apparatus, the antenna wire is elongated and becomes more effective as an antenna (column 3, lines 41-45). The deployable voice port can then be placed in or near the user's ear while the other voice port (microphone 132) is placed adjacent the user's mouth. Alternatively, the deployable voice port may be placed adjacent the user's mouth while the other voice port is placed adjacent the user's ear (column 1, line 67, to column 2, line 5). In other words, Houlihan teaches

that either the microphone or the speaker voice port can be mounted on the end of tether member 136 for deployment from the device (see also column 5, lines 28-32). As explained in the last paragraph in column 3, Houlihan's tether member 136 is preferably retracted into structure 130 on a reel inside the structure.

The examiner correctly found that Houlihan disclosed a physically-shortened antenna 136, but, incorrectly in our opinion, found that Houlihan fails to disclose a microphone mounted on that physically-shortened antenna, as called for in each of appellant's independent claims 1 and 10 (answer, page 3).<sup>1</sup> In order to overcome this perceived deficiency of Houlihan, the examiner relied upon the teachings of Shiraki for a suggestion to mount a microphone for a wireless communication device on a physically-shortened antenna. The examiner's position appears to be that it would have been obvious to replace the tether member and voice port of Houlihan with a helical antenna and microphone as taught by Shiraki "in order to improve miniaturization" and to "minimize the space required for the antenna" (answer, page 4). We find ourselves in agreement with appellant (reply brief, page 4), however, that Shiraki discloses building the microphone 7 into an air-core formed in the helical antenna and thus would not have suggested a microphone "mounted on said

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<sup>1</sup> As explained above, Houlihan discloses (column 1, line 67, to column 2, line 5; column 5, lines 28-32) that either the microphone (voice input port) or the speaker (voice output port) may be placed on the tether member 136.

physically-shortened antenna" (emphasis added) as required by claims 1 and 10. It follows that we cannot sustain the examiner's rejection of claims 1 and 10, or claims 2, 5, 7, 9, 11, 14, 17 and 18 depending therefrom, as being unpatentable over Houlihan in view of Shiraki.

The examiner's rejections of the remaining dependent claims 3, 4, 6, 8, 12, 13, 15 and 16 are grounded on the same flawed position with regard to the combination of Houlihan and Shiraki discussed above. Accordingly, we also cannot sustain the rejections of claims 3 and 12 as being unpatentable over Houlihan in view of Shiraki and Hirai, claims 4 and 13 as being unpatentable over Houlihan in view of Shiraki and Barnard and claims 6, 8, 15 and 16 as being unpatentable over Houlihan in view of Shiraki and McLean.

NEW GROUND OF REJECTION

We enter the following new ground of rejection pursuant to 37 CFR § 41.50(b).

Claims 1, 5, 10 and 14 are rejected under 35 U.S.C. § 102(b) as being anticipated by Houlihan.<sup>2</sup>

As explained above, we conclude that the examiner's determination that Houlihan fails to disclose a microphone mounted on the physically-shortened antenna, as called for in each of appellant's claims 1 and 10 (answer, page 3) is in error. As explained above, Houlihan discloses (column 1, line 67, to column 2, line 5; column 5, lines 28-32) that either the microphone (voice input port) or the speaker (voice output port) may be placed on the tether member 136. Inasmuch as neither the examiner nor the appellant has identified any other difference between the subject matter of claims 1 and 10 and Houlihan, and we find no such difference, we conclude that claims 1 and 10 are anticipated by Houlihan. As for claims 5 and 14, as illustrated in Figure 1 of Houlihan, the voice port mounted on the end of the tether member 136 is located at an end of the tether member furthest from the casing (structure 130).

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<sup>2</sup> We leave to the examiner consideration of the patentability of the remaining claims over Houlihan in view of other prior art.

### CONCLUSION

To summarize, the decision of the examiner to reject claims 1-18 under 35 U.S.C. § 103 is reversed and a new ground of rejection of claims 1, 5, 10 and 14 under 35 U.S.C. § 102(b) is entered pursuant to 37 CFR § 41.50(b).

This decision contains a new ground of rejection pursuant to 37 CFR § 41.50(b) (effective September 13, 2004, 69 Fed. Reg. 49960 (August 12, 2004), 1286 Off. Gaz. Pat. Office 21 (September 7, 2004)). 37 CFR § 41.50(b) provides "[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review."

37 CFR § 41.50(b) also provides that the appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of the appeal as to the rejected claims:

(1) *Reopen prosecution*. Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the proceeding will be remanded to the examiner. . . .

(2) *Request rehearing*. Request that the proceeding be reheard under § 41.52 by the Board upon the same record. . . .

No time period for taking any subsequent action in connection with this appeal  
may be extended under 37 CFR § 1.136(a).

REVERSED; 37 CFR § 41.50(b)



JERRY SMITH  
Administrative Patent Judge



JEFFREY V. NASE  
Administrative Patent Judge



JENNIFER D. BAHR  
Administrative Patent Judge

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